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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/446,839	03/24/2000	Ernst Michael Winter	45/276 LI/SCH	2969
30996	7590	10/31/2005		
ROBERT W. BECKER & ASSOCIATES 707 HIGHWAY 66 EAST SUITE B TIJERAS, NM 87059			EXAMINER LAVINDER, JACK W	
			ART UNIT	PAPER NUMBER
			3677	

DATE MAILED: 10/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/446,839

Applicant(s)

WINTER ET AL.

Examiner

Jack W. Lavinder

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 14-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 14, the phrase "said gemstone being suitable only for technical or industrial purposes" is considered indefinite. What is the scope of this limitation? First, what are technical or industrial purposes? Secondly, the scope of the limitation is indefinite. Some gemstones considered only for industrial purposes have been used to ornate jewelry, i.e., crushed diamonds have been embedded in rings, bracelets or necklaces. Only types of stones, cut or uncut, polished or unpolished can be used for something other than technical or industrial purposes. Crushed or broken diamonds or any other precious or semiprecious stones can be used in making artwork or jewelry. Also, uncut and unpolished stones can be used in rock gardens or in mosaics or in jewelry.

The term "gemstone" according to Webster's New Riverside University Dictionary is defined as "A precious or semiprecious stone that may be used as a jewel when cut and polished." The phrase "only for technical or industrial purposes" in the limitation contradicts with the definition that the gemstone "may be" used as a jewel when cut and polished. In other words, the term gemstone encompasses cut and polished stones and

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uncut and unpolished stones. Is the applicant intending by the phrase "only for technical or industrial purposes" to narrow the gemstone to be only precious and semiprecious stones that are uncut and unpolished? If they are, the limitation is still unclear, since uncut and unpolished stones can be and have been used in jewelry.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 14-18, 20, 22-25 are rejected under 35 U.S.C. 102(b) as being anticipated by Normann, Jr., 4809417.

Regarding claim 14, Normann, Jr. discloses a gemstone body (14) with a visible surface (28), i.e., visible through the top part (12, col. 3, lines 5-10), that supports a precious metal (gold, col. 3, lines 65-end and column 4, lines 1-11) structured material layer.

Regarding claim 15, Normann, Jr. discloses that the visible surface is smooth (28).

Regarding claims 16 and 17, Normann, Jr. discloses that the material layer is gold, which is considered to be shiny and a precious metal.

Regarding claim 18, Normann, Jr. discloses an intermediary retention layer (48, zirconium, col. 6, lines 21-38) in between the visible surface (28) and the gold material layer (50).

Regarding claim 20, Normann, Jr. discloses a body that can be made of a multitude of materials (col. 3, lines 35-56), which includes a diamond. The process by which the diamond is formed is given weight insomuch as to the final structure achieved by the process, i.e., a diamond support layer. Normann, Jr. discloses a diamond support layer (14, 40).

Regarding claim 22, Normann, Jr. discloses a level visible surface (28).

Regarding claim 23, Normann, Jr. discloses a transparent protective layer (12 or 70).

Regarding claim 24, Normann, Jr. discloses a protective layer made from diamond (col. 3, lines 6-11).

Regarding claim 25, Normann, Jr. discloses a body adapted to form a face of a clock, i.e., the flat level surface (28) of the body is ideal for forming a clock face, albeit a small clock face.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 19 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Normann, Jr.

Regarding claim 19, Normann, Jr. discloses an intermediary layer made from zirconium. The claim requires that the layer be made from titanium or chromium.

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These materials are well known to the artisan for changing the color or look of jewelry.

It would have been an obvious design choice to use either of the known materials, titanium or chromium, in place of Normann, Jr.'s zirconium material in order to produce a different colored jewelry item to be more pleasing to the wearer.

Regarding claim 21, Normann, Jr. discloses that a multitude of different materials can be used (col. 3, lines 35-56) to form the support body of the jewel. Polycrystalline diamond aggregate is an old and well known material. It would have been an obvious design choice to make Normann, Jr.'s diamond support from polycrystalline diamond aggregate, in order to vary the final appearance of the jewel to make it more attractive to the wearer.

Response to Arguments

7. Applicant's arguments filed 8/25/05 have been fully considered but they are not persuasive.

The applicant argues on pages 5 and 6 of their remarks that the language "suitable only for technical or industrial purposes" is definite. The reasons proffered by applicant are that certain stones cannot be cut into gemstones because of their original size, purity or color.

Contrary to the Examiner's newly raised arguments, these types of gemstones normally are not suitable for use in jewelry, because, for example, they are of insufficient size, purity, or color. A large number of these gemstones cannot be processed further into jewelry items, which represents a considerable economic drawback, because the economic value of industrial gemstones naturally is much less than gemstones that are able to be used in jewelry.

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In their arguments, the applicant is firstly stating that "these types of gemstones normally are not suitable for use in jewelry, because, for example, they are of insufficient size, purity, or color." Thus, if the language was considered definite, one having skill in the art would understand that these types of stones would not be suitable for cutting or grinding into a gemstone or for jewelry purposes.

However, the applicant then states that "A large number of these gemstones cannot be processed further into jewelry items..." This second statement implies that some of these types of stones can be made into a gemstone by cutting and grinding or wrapping with wire and hanging on a necklace. This statement supports the examiner's 112 second paragraph rejection in that the phrase "suitable only for technical or industrial purposes" is indefinite. The applicant is stating that most of these types of stones cannot be processed into jewelry items. What about the other stones that are of insufficient size, purity, or color?

Apparently, there are some of these types of stones that can be processed into jewelry. This is why the scope of the claims cannot be determined. According to applicant's own statements, the stones in question are not only suitable for technical or industrial purposes, but some of them can be used to make jewelry.

Why is it that some of the stones can be used to make jewelry? What is the difference in these stones when compared to the other stones with insufficient size, color or purity? Applicant's statements are direct evidence of the indefiniteness of the phrase "suitable **only** for technical or industrial purposes."

Furthermore, any type of stone, cut or uncut, can be used for a jewelry item—even stones that are not capable of being cut into a brilliant gemstone. Therefore, there are no gemstones/stones that are "suitable **only** for technical or industrial purposes."

The applicant argues on page 9 the following:

However, claim 14 includes additional features that are not addressed by the Examiner in his analysis of the Normann reference. Specifically, claim 14 includes the features "and wherein at least one theme or image is formed from the structure of the material layer." This is achieved in that the material layer, as shown in Fig. 1 of the present application for example, is structured by using lithographic techniques

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to ablate the material layer at a number of discontinuous portions, thus making the gemstone 3 discernable. From an observer's point of view, this results in a pixel pattern (as in a photograph) of a first color (gemstone 5) and of a second color (material layer-pixels 5).

The claim states that "at least one theme or image is formed from the structure of the material layer." I am not sure what the applicant is alluding to in the above argument. However, the claim language is very clear and a

reasonable interpretation of the language would be that the structure, i.e., the gold layer 16, forms an image of the letter "D" from the structure of the material, i.e., visual indicia.

If the applicant is intending that the claim language mean something other than what it says, they must clearly define what they would like it to mean in the claim.

The applicant also states the

In contrast, Figure 9 of Normann shows the generation of an object, or indicia, namely, a cross 66 from a gold layer by means of lithographic techniques. However, Normann fails to disclose in any manner the generation of an *image* by lithographic techniques, specifically, from the *structure* of the material layer.

The manner or method of making the structure is given patentable weight as to the structure that is achieved by that method of making. As long as the reference discloses structure that is the same as the claimed structure that is inferred by the method step of making it, the claim limitations have been met by the reference. The use of the lithographic techniques is assumed to form a layer of material on the gemstone. Normann, Jr. discloses just such a layer. In order to overcome the rejection based on the method limitations, applicant must prove that the structured layer in Normann, Jr. could not have ever resulted from a lithographic technique. There must be some distinct structural differences achieved from the lithographic technique. However, as admitted by applicant,

Normann, Jr. discloses the use of lithographic techniques for forming the structure material layer (16, col. 6).

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

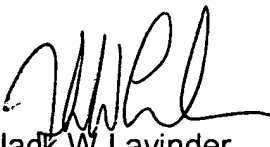
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jack W. Lavinder whose telephone number is 571-272-7119. The examiner can normally be reached on Mon-Friday, 9-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Judy Swann can be reached on 571-272-7075. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jack W Lavinder
Primary Examiner
Art Unit 3677

10/27/05